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| APPLICATION NO.                                             | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/089,131                                                  | 03/25/2002  | Tomaya Hidaka        | 1576.100            | 2506             |
| 24040                                                       | 7590        | 07/07/2004           | EXAMINER            |                  |
| MASON LAW, PL<br>17757 US HWY 19 N.<br>CLEARWATER, FL 33764 |             |                      | KUMAR, SHAILENDRA   |                  |
|                                                             |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                             |             |                      | 1621                |                  |
| DATE MAILED: 07/07/2004                                     |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/089,131 | <b>Applicant(s)</b><br>HIDAKA ET AL. |  |
|                              | <b>Examiner</b><br>SHAIENDRA - KUMAR | <b>Art Unit</b><br>1621              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

This office action is in response to applicants' communication filed on 4/12/04.

Claims 1-6 are pending in this application.

Rejection of claim under 35 USC 102(b) over Jones et al is hereby withdrawn

subsequent to applicants' amendment.

*Allowance of Claims 2-6 are hereby withdrawn, and following office action is in order.*

#### **Claim Rejections - 35 USC § 103**

1. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al.

Lau et al, in column 6, lines 30-50 teach structurally similar compounds as claimed herein. Note Z can be hydrogen, X can be halogen, R3 can be alkyl, R7 can be hydroxy and R4 and R5 can be hydrogen. The difference between the reference and herein claimed compounds are that the reference has not made any specific compounds as made herein. However, due to structural similarity, it would have been prima facie obvious to one of ordinary skill in the art to make compounds within the generic structure of the reference, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving successful photographic element, absent evidence to the contrary.

Applicant's argument that the reference compounds have different utility than herein, is of little if any probative value inasmuch as applicants are claiming compounds.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al.

Tsuchiya et al is teaching structurally similar compounds as claimed herein for the thermo sensitive recording sheet. Note, column 2, compound (1), wherein Y can be hydroxy, X1 can be sulfur, R5 can be phenyl substituted with hydroxy. The difference between the reference and herein claimed compounds is that the reference has not made specific compounds as made in herein.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic disclosure of the reference, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving compounds for using as thermo sensitive recording sheet, absent evidence to the contrary.

Applicants' comparative data is not convincing for two reasons. It is not in the declaration form, and 36<sup>th</sup> compound of the reference does not match with example cited in the remarks. Note the thermo sensitive recording sheet has the same meaning as thermo recording material.

3. No claim is allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Shailendra Kumar', with a stylized circular mark at the beginning.

SHAIENDRA - KUMAR  
Primary Examiner  
Art Unit 1621

S. Kumar  
7/5/04